

REMARKS

1. Summary of the office action

In the office action mailed July 24, 2008, (i) the Examiner objected to claims 76 and 77 because the claims should be 'computer program product' claims, not method claims, (ii) the Examiner rejected claims 2 and 3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; (iii) the Examiner rejected claims 1-3, 5, 7, 8, 11-15, 17-23, 38, 49-51, 55, 56, 59-63 and 66-79 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0083439 (Eldering) in view of U.S. Patent No. 5,948,061 (Merriman), and (iv) the Examiner rejected claims 31, 39, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Eldering in view of Merriman and U.S. Patent No. 7,017,173 (Armstrong).

2. Amendments and pending claims

Applicant has amended claims 1, 2, 12, 38, 49-51, 61, 76 and 77 and added new claims 80-83. Claims 1-3, 5, 7, 8, 11-15, 17-23, 31, 38, 39, 49-52, 55, 56, 59-63, and 66-83 are pending. Of the pending claims, 1, 38, 49, and 51 are independent.

3. Response to claim objections

The Examiner objected to claims 76 and 77 because the claims should be 'computer program product' claims, not method claims. Applicant has amended claims 76 and 77 to be "computer program product" claims. Applicant believes that the amendments to claims 76 and 77 overcome the Examiner's objection of these claims. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection of claims 76 and 77.

4. Response to claim rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 2 and 3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner indicated that there is no antecedent basis for the change of context. The term in claims 2 and 3 that lacked antecedent basis was “the change of viewing context in the client.” Applicant has amended claim 2 to depend from claim 12 instead of claim 68. Claim 12 provides claims 2 and 3 with an antecedent basis for the term “the change of viewing context in the client.” Claim 12 depends on claim 61 and claim 61 depends on claim 1. Applicant believes the amendments of claims 2, 12, and 61 overcome the rejection of claims 2 and 3 under 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection of claims 2 and 3.

5. Response to claim rejections under 35 U.S.C. § 103(a)

The Examiner rejected independent claims 1, 38, 49, and 51 under 35 U.S.C. § 103 (a) as being unpatentable over Eldering in view of Merriman. Applicant submits that the Examiner did not establish *prima facie* obviousness of claims 1, 38, 49, and 51.

In particular, in rejecting claims 1, 38, 49, and 51, the Examiner indicated that the primary reference Eldering does not teach a weighted placement value for ads derived by a product of a re-determined placement value and the ads weight value. (See, office action, page 4, lines 19-20). In claim 1, as amended, the functionality not taught by Eldering includes “the client multiplying the re-evaluated placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad.” In claim 38, as amended, the functionality not taught by

Eldering includes “the client-side machine multiplying the re-evaluated placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad.” In claims 49 and 51, the functionality not taught by Eldering includes “multiplying the re-evaluated placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad.”

To make up for the deficiency of Eldering, the Examiner argued that Merriman provides a satisfaction index for the ads of advertising campaigns that acts as a weighted placement value, and the index (weighted placement value) is derived for each ad using a product of ratios representing the (continually re-determined) percentage of desired ad quantity impressions and the percentage of elapsed campaign durations. (See, office action, page 4, line 22 to page 5, line 4). The Examiner then argued that doing so enables Merriman to automatically adjust advertising impressions if they are running ahead (or behind) of schedule so as to more accurately accomplish the advertiser’s campaign goals over time, and that any of the 4 specified values (or certain combinations of them) of Merriman can be taken to represent the claimed “weight value” and “re-determined placement value.” (See, office action, page 5, lines 4-8). The Examiner then further argued that it would have been obvious to one of ordinary skill at the time of the invention to have provided such a feature with the continually re-ordered advertising queue of Eldering, so that ad campaigns can be better managed with respect to impression rate/goals. (See, office action, page 5, lines 8-11).

Applicant submits that it would not have been obvious to one of ordinary skill at the time of the invention to modify Eldering with Merriman's formula for a satisfaction index so as to arrive at the claimed invention.

With respect to Eldering, Eldering discloses a set top box or personal video recorder *of a subscriber* that includes an ad processing unit coupled to a display device (e.g., a TV). The ad processing unit determines the next ad or ads to be inserted into the upcoming avails of the programming channel, and the order in which these ads are to be inserted into the programming channel. The *ad processing unit may also readily change the ad insertion schedule* so that the most appropriate ads are actually inserted into the incoming programming channel. *Changes in one or more of certain viewing parameters* may warrant a change in the ad insertion schedule since the currently scheduled ads may not be appropriate in view of the change in the viewing parameters. Such viewing parameters may include, but are not limited to, channel selection, viewer identity, and the type of program being watched. (See, Eldering, paragraphs 0015-0016).

On the other hand, Merriman provides for targeting the delivery of advertisements over a network such as the Internet, and *compiling statistics on individual users and networks* and tracking the use of advertisements to permit targeting of the advertisements of individual users. (See, e.g., Merriman, abstract). In particular, Merriman discloses an advertising server transmits to people accessing a page of a site an appropriate advertisement *based upon profiling of users and networks*. (See, e.g., Merriman, abstract). Merriman also discloses that any number of algorithms may be used to select a particular advertisement to transmit back to a user, and in an embodiment, the formula

used is based upon a satisfaction index (SI) according to the following formula:

$$SI = \frac{n}{N} * \frac{\text{end} - \text{start}}{\text{now} - \text{start}} . \text{ (See, e.g., Merriman, col. 6, lines 29-38).}$$

Applicant submits that modifying Eldering with Merriman would change Eldering's principle of operation. As far as Applicant can tell, in Eldering, changes to an ad insertion schedule are based on viewing parameters local to the subscriber device that includes the ad processing unit. However, as far as Applicant can tell, parameter 'n' of Merriman's satisfaction index is based on the compiled statistics pertaining to multiple users across a network (i.e., 'n' equals the number of times the particular advertisement has been viewed by anyone). Applicant submits that use of the parameter 'n' to determine the satisfaction index would modify the operation of Eldering because the parameter 'n' does not amount to a viewing parameter of a set top box or personal video recorder of a subscriber. Because modifying Eldering with Merriman's use of the satisfaction index would change Eldering's principle of operation, Applicant submits that the Examiner did not establish *prima facie* obviousness of claims 1, 38, 49, and 51.

Because the Examiner did not establish *prima facie* obviousness of claims 1, 38, 49, and 51, Applicant submits that claims 1, 38, 49, and 51 are allowable. Further, without conceding the assertions made by the Examiner regarding dependent claims 2, 3, 5, 7, 8, 11-15, 17-23, 31, 39, 50, 52, 55, 56, 59-63, and 66-79, Applicant submits that dependent claims 2, 3, 5, 7, 8, 11-15, 17-23, 31, 39, 50, 52, 55, 56, 59-63, and 66-79 are allowable for at least the reason that they depend from one of allowable claims 1, 38, 49, and 51.

Additionally, with respect to claims 1 and 38, Eldering and Merriman do not teach or suggest all of the elements recited in either of these claims. In particular, Eldering and Merriman do not teach or suggest (i) the *client* multiplying the re-evaluated placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad, as recited in claim 1, and (ii) the *client-side machine* multiplying the re-evaluated placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad, as recited in claim 38.

As indicated above, the Examiner indicated that the primary reference Eldering does not teach a weighted placement value for ads derived by a product of a re-determined placement value and the ads weight value. The Examiner relied on Merriman's disclosure of the satisfaction index to make up for the deficiency of Eldering. As far as Applicant can tell, Merriman discloses that the satisfaction index is used by an advertising *server* process to select a particular advertisement to transmit back to the user (e.g., a client of the advertising service process).

Even if, for the sake of argument, it is assumed that use of the satisfaction index amounts to multiplying the re-evaluated placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad, Applicant submits that Merriman, alone or in combination with Eldering, does not teach or suggest that a client or client-side machine uses that satisfaction index. Thus, for this alternative reason, Eldering and Merriman do not reasonably lead to the invention recited in claims 1 and 38 and Applicant submits that claims 1 and 38 are allowable.

6. New claims

Applicant has added new claims 80-83. Claims 80-83 are allowable because each of these claims depends from one of allowable claims 1, 38, 49, and 51. However, should the Examiner continue to reject claims 1, 38, 49, and 51 as being obvious over Eldering and Merriman, in the alternative, Applicant submits that claims 80-83 patentably distinguish over Eldering and Merriman.

In particular, Eldering and Merriman do not reasonably lead to, for each of the at least one of the ads associated with a respective weight value, multiplying the re-evaluated placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad, wherein each respective weight value is a ***constant weight value***, as recited in new claims 80-83.

In rejecting claims 1, 38, 49, and 51, the Examiner stated, "Eldering does not appear to teach a weighted placement value for ads derived by a product of a re-determined placement value and the ads weight value." (See, office action, page 4, lines 19-20). To make up for the deficiency of Eldering, the Examiner argued that Merriman teaches methods for selecting suitable ads targeted to a viewing user's profile and that Merriman provides a satisfaction index for ads of an advertising campaign that acts as a weighted placement value. (See, office action, page 4, line 20 to page 5, line 1). The Examiner then argued that the index (weighted placement value) is derived for each ad using a ***product of ratios*** representing the (continually re-determined) percentage of desired ad quantity impressions and the percentage of elapsed campaign duration. (See, office action, page 5, lines 1-4, emphasis added). The Examiner then further argued that any of the 4 specified values (or certain combinations of them) of Merriman can be taken

to represent the claimed “weight value” and “re-determined placement value.” (See, office action, page 5, lines 6-8). The Examiner cited to column 6, lines 27-59 of Merriman in support of these arguments.

Merriman discloses that any number of algorithms may be used to select a particular advertisement to transmit back to a user, and in an embodiment, the formula used is based upon a satisfaction index (SI) according to the following

formula:
$$SI = \frac{n}{N} * \frac{\text{end} - \text{start}}{\text{now} - \text{start}}$$

According to Merriman, “n” equals the number of times a particular advertisement has been viewed by anyone, “N” is the number of times the advertisement is to be seen by anyone, “end-start” is the total number of days that the advertisement is scheduled to run, and “now-start” is the number of days that the advertisement has run to date. (See, Merriman, col. 6, lines 40-47). Merriman also discloses that statistics are compiled on individual users and networks and the use of the advertisements is tracked to permit targeting of the advertisement of individual users, and a report process generates statistics on the users that are viewing and clicking through on various advertisements and updates the counters in a database that stores how often an advertisement has been displayed. (See, Merriman, abstract and col. 4, lines 37-42).

However, even if, for the sake of argument, it is assumed that one of the 4 values (i.e., “n,” “N,” “end-start,” and “now-start”) or a combination of the 4 values amounts to a “weight value,” Applicant submits that Eldering and Merriman do not reasonably teach or suggest, for each of the at least one of the ads associated with a respective weight value, multiplying the re-evaluated placement value associated with that ad by the weight

value associated with that ad so as to determine a weighted placement value for that ad, wherein each respective weight value is a *constant weight value*.

At best, Merriman discloses determining a satisfaction index by multiplying two ratios, namely “n/N” and “end-start/now-start.” Applicant submits that the ratio “n/N” does not amount to a constant weight value because “n” is a variable and thus the ratio “n/N” is a variable ratio. As indicated above, Merriman discloses “n” is equal to a number of times a particular advertisement has been viewed by anyone, and Merriman discloses updating the counters in a database that stores how often an advertisement has been displayed. Applicant further submits that the ratio “end-start/now-start” does not amount to a constant weight value because “now-start” is a variable and thus the ratio “end-start/now-start” is a variable ratio. As indicated above, Merriman discloses that “now-start” is equal to the number of days that the advertisement has run to date. Applicant submits that “now-start” would change each subsequent date that the advertisement is run.

Since Merriman merely discloses determining a satisfaction index by determining the product of two variable ratios, Applicant submits that even if Eldering is modified with Merriman, the combination of Eldering and Merriman fail to teach or suggest, for each of the at least one of the ads associated with a respective weight value, multiplying the re-evaluated placement value associated with that ad by the weight value associated with that ad so as to determine a weighted placement value for that ad, wherein each respective weight value is a *constant weight value*, as recited in claims 80-83.

Because Eldering and Merriman fail to reasonably lead to the invention recited in claims 80-83, Applicant submits that claims 80-83 are allowable.

7. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 1-3, 5, 7, 8, 11-15, 17-23, 31, 38, 39, 49-52, 55, 56, 59-63, and 66-83 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

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